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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,001	03/16/2001	Michael John Brosnan	10010038-1	7300

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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 04/28/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,001

Applicant(s)

BROSNAN, MICHAEL JOHN

Examiner

HENRY N TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the applicant's amendment received 6/6/03 (Paper No. 5). The amendments to the claims have been entered. Claims 1-22 remain pending in this application. Applicant's remarks have been fully considered, with the results set forth as following.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The new claimed term "two-dimensional relative movement" appearing in claim 1 has no clear support in the specification.

The use of a confusing variety of terms for the same things is not allowed: "a motion sensor" (claims 1-10 and 14-17), "a motion detector" (claims 18-22), and "a motion detector device" (specification, page 7, lines 15-16).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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4. Claims 1, 2, 4-7, 10, 11, 13-15, 18, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Paloniemi et al (U.S. Pub. No. 2001/0017934 A1, hereinafter referred to as "Paloniemi").

Paloniemi teaches all the claimed invention. Paloniemi teaches an apparatus and methods for selecting menu item displayed on a display screen, or for identifying the user of a portable electronic device, the apparatus comprising: a display 8 displaying menu items 20 and a pointer 21; a memory 9; a motion detector or fingerprint sensor 5 for sensing relative movements of a user's finger across the sensor for generating sets of movement data (up and down motions read on a first set of movement data; leftward or rightward motion, or a finger tap read on a second set of movement data) for the controller (a detector circuitry 12 and control processor 3) to move the pointer correspondingly up or down to select a highlighted item (option), or to identify the user of the device; see figures 1-5; paragraphs. [0007], [0017], [0019]-[0020], [0022], [0027]-[0032], and [0037].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 8, 9, 12, 16, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paloniemi in view of Gordon et al (U.S. Patent No. 6,057,540, hereinafter referred to as "Gordon").

Paloniemi teaches generally all, including an array of photo detectors 11 for outputting signals representing images, the menu display and the sensor are positioned in the front side of the housing, see figures 2 and 3. However, Paloniemi does not teach the motion sensor further comprising the claimed elements: light source, a lens, and the motion sensor is positioned on a backside of the portable electronic device. Gordon teaches an optical motion sensor arrangement 1 comprising light source 2 and a lens 3 for reflecting user's fingertip images detected by the motion detector 9 when a user's finger 7 moves across the sensor surface 5; and the motion sensor arrangement may be altered; see figures 1 and 2; col. 3, lines 34-58; col. 8, lines 42-49; and col. 9, lines 36-43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Gordon in the Paloniemi device for producing the claimed invention because using the light source and lens would effectively improved the detection of the an imaging surface, and positioned the motion sensor on a back side of the portable electronic device would be conveniently adapted for operating by the user's finger while holding the device. Claims 3, 8, 9, 12, 16, 17, 20 and 21 are dependent upon the base claims 1, 5, 11, 14 and 18, and are rejected on the same basis set forth in base claims, and by the reasons discussed above.

Response to Arguments

7. Applicant's arguments with respect to drawings have been noted, and overcome the objections recited in the prior Office action.

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection as discussed above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are: 5801681, 4920260 and 6281882, which teach optical sensors for electronic devices.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is 703-308-8410. The examiner can normally be reached on Mon – Fri from 8:00AM – 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at 703-305-4709.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

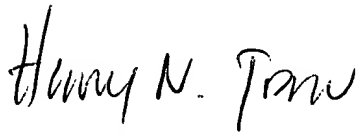
or fax to:

703-872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

A handwritten signature in black ink that reads "Henry N. Tran". The signature is written in a cursive, flowing style.

HENRY N. TRAN
Examiner
Art Unit 2674

Hnt
April 26, 2004